

Applicant: Bhalakia et al.
Serial No.: 09/848,594
Group Art Unit: 1773

PATENT
Docket No.: 10-9393

REMARKS

This Amendment is submitted in response to the Final Official Action dated February 20, 2004. Entry of this amendment and allowance of the application is hereby requested.

Claims 1-79 have at various times been pendent before the examiner in the present application. Prior to entry of this Amendment, claims 1-49 were Cancelled and claims 59-79 were withdrawn from consideration, leaving claims 50-58 pending. Of those remaining claims, claim 50 is independent and claims 51-58 are dependent therefrom. After entry of this Amendment claims 50 will have been amended, claims 51-58 will remain unchanged, claims 59-79 will be Cancelled and new dependent claims 80-83 will have been added. This will leave claims 50-58 and 80-83 as pending in the application.

A. Examiner Interview

On June 16, 2004, the Examiner granted the courtesy of an interview with the undersigned. The Examiner is thanked for granting the interview.

At the interview, claim 50 as amended herein was proposed and discussed. After discussion concerning amended claim 50, it was decided that an after-final response that formally proposed amended claim 50 should be filed. This amendment constitutes that after-final response.

B. Claim Rejections Under 35 U.S.C. Sections 102(b) and 103

The Examiner has rejected claims 50-57 under 35 U.S.C. Section 102(b) based on U.S. Patent No. 5,051,309 (*Kawaki et al.*) The Examiner has rejected claim 58 under 35 U.S.C. Section 103 based on the combination of the *Kawaki et*

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al. reference and U.S. Patent No. 5,631,720 (*Guglielmetti et al.*) For the reasons set forth below, the rejections are hereby traversed.

In the final rejection, the Examiner stated several times that arguments previously presented as to the rejection of claim 50 based on *Kawaki et al.* were unpersuasive since claim 50 is directed to a laminate and not an injection molded lens. The Examiner is correct that claim 50 is not directed *per se* to an injection molded lens. However, it is submitted as incorrect to characterize claim 50 as being directed to a laminate *per se*. In fact, claim 50 is directed to a laminate "***for an injection molded eye lens***" and many of the structural limitations in claim 50 are present in the claim precisely because the laminate is "***for an injection molded eye lens***" (see claim 50 preamble) and not a laminate *per se*.

For example, claim 50 recites an "adhesive formulated to have sufficient flexibility so as to substantially prevent crazing during ***injection molding of said lens***"; and, "a center thickness in the range of about .2mm to about 2mm ***on said injection molded lens***". And now, after this amendment, Claim 50 recites that it has "cut edges such that said laminate has a dimension that snugly conforms to a ***mold cavity*** corresponding to a front surface ***of said injection molded lens***" (emphasis added). Each of these structural elements for the claimed laminate are recited specifically with reference to an injection molded lens. And these limitations are not merely words of "intended use."

Take for example the structural element directed to the cut edges of the laminate being such that the laminate has a dimension that snugly conforms to a mold cavity corresponding to a front surface of said injection molded lens. The dimension that is achieved by cutting the edges of the laminate of the present invention in this manner is very important structurally to the injection molded lens that is being made since the laminate must snugly fit within the mold in order to achieve an acceptable injection molded lens.

This important structural feature of the laminate is discussed at some length in the specification. For example, on page 31, lines 9-12, it is stated that

Applicant: Bhalakia et al.
Serial No.: 09/848,594
Group Art Unit: 1773

PATENT
Docket No.: 10-9393

"the plates [i.e., the laminate] 17 must be properly sized to take into account expansion of the metal used to make the mold halves 122, 124 so that the plates [i.e., the laminate] 17 remain **snug** and secure within the recesses 172 when molten resin is injected into the mold cavities 104" (emphasis added). Furthermore, at page 31, line 15, in connection with pneumatic sealing of the laminate in the mold it is again emphasized that the laminate be dimensioned so as to maintain the laminate in "**snug** registry" in the mold "while molten resin is injected into the mold cavities 104" (emphasis added). Finally, in the Examples disclosed at page 35, line 22; page 41, line 9; page 44, line 13, the "**snug** fit" in the mold provided by the dimensions of the cut edges of the laminate are each observed in establishing the actual reduction to practice of the invention.

At least this structural element of claimed 50 is missing in the *Kawaki et al.* reference. In fact, as acknowledged by the Examiner, the only disclosure in the *Kawaki et al.* reference concerning the "dimensions" of the laminate therein is with regard to items such as sunglasses, goggles, etc. And forming a three layer laminate film so that it simply fits within a frame for sunglasses or goggles is considerably distinct from cutting a laminate to a precise dimension so that it can be properly used in a mold with a molten substance to achieve an optically acceptable injection molded eye lens.¹ Hence, for at least this additional reason, it is again submitted that the *Kawaki et al.* reference does not anticipate claim 50.

As to claims 51-58, these claims each depend from claim 50 and are thus patentable for at least the aforestated reasons. However, these claims further distinguish the present invention and are independently patentable. For example, claims 55 and 56 are directed to a laminate for use in an injection molded lens with prescription power (claim 55) and one without prescription power (claim 56). As stated in the previous amendment (and conceded by the Examiner in the final Office Action), there are significant differences between an

¹ Nor is there any suggestion in *Kawaki et al.* to cut a laminate in this way. Indeed, nowhere in *Kawaki et al.* is there any mention whatsoever of using the laminate disclosed therein in connection with an injection molded lens. And to assert to the contrary would, of course, constitute improper hindsight.

Applicant: Bhalakia et al.
Serial No.: 09/848,594
Group Art Unit: 1773

PATENT
Docket No.: 10-9393

injection molded lens with a prescription power and one without. These lenses have different manufacturing constraints that are effected by the laminate used therein (see, e.g., the specification at Page 3, lines 27 through page 4, line 11 which specifically discusses the *Kawaki et al.* reference).

As to claim 58, there is no apparent disclosure in either the *Kawaki et al.* reference or the *Guglielmetti et al.* reference to use a photochromic layer in a laminate for an injection molded lens. In fact, as evidenced in the current application, the inventors were led to formulate their own laminate having photochromic properties since the inventors could not locate any such prior art photochromic laminates, let alone those needed for an injection molded lens. Hence, the obviousness rejection fails as well.

Finally, as to newly added claims 80-83, these claims further define and describe the present invention and have support in the specification. No new matter is added.

Applicant: Bhalakia et al.
Serial No.: 09/848,594
Group Art Unit: 1773

PATENT
Docket No.: 10-9393

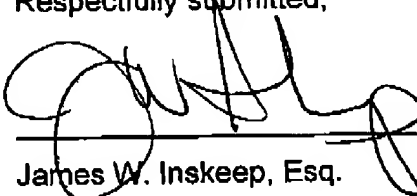
CONCLUSION

In view of the foregoing, it is submitted that all claims pending after entry of this amendment (namely, claims 50-58 and 80-83) are in condition for allowance and thus that entry of this amendment is appropriate. If any questions or issues arise that are more easily addressed by the Examiner through direct communication with the undersigned, the Examiner is cordially to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: June 16, 2004



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